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PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Applicants: HAN
Application No.: 09/069,847
Filed: 04/30/98
For: FLUOROMETRIC ASSAY FOR DETECTING
NUCLEIC ACID CLEAVAGE

Filed by: Judge Sally Gardner-Lane
Telephone: (703) 308-9797
Facsimile: (703) 305-0942

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 104,670.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).


SALLY GARDNER-LANE
Administrative Patent Judge

INTERFERENCE DIGEST

Interference No. 104,670

Paper No. 23

Name: Myun Ki Han et al.

Serial No.: 09/069,847

Patent No.

Title: FLUOROMETRIC ASSAY FOR DETECTING NUCLEIC ACID CLEAVAGE

Filed: 04/30/98

Interference with Livak et al.

DECISION ON MOTIONS

Administrative Patent Judge, _____ Dated, _____

FINAL DECISION

Board of Patent Appeals and Interferences, _____ Dated, _____

Court, _____ Dated, _____

REMARKS

This should be placed in each application or patent involved in interference in addition to the interference letters.

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 1

Filed by: Sally Gardner-Lane
Administrative Patent Judge
Box Interference
Washington, D.C. 20231
Tel: 703-308-9797
Fax: 703-305-0942

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MYUN KI HAN,
S. PAUL LEE, and JACK G. CHIRIKJIAN,

Junior Party,
(Patent Application 09/069,847),

v.

KENNETH J. LIVAK,
SUSAN J.A. FLOOD, and JEFFREY MARMARO,

Senior Party,
(Patent 5,538,848).

Patent Interference No. 104,670

NOTICE DECLARING INTERFERENCE
(37 CFR § 1.611)

Part A. Declaration of interference

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties.

Details of the application(s), patent (if any), reissue application (if any), count(s) and claims designated as corresponding or as not corresponding to the count(s) appear in Parts E and F of this NOTICE DECLARING INTERFERENCE.

MAILED

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Part B. Judge designated to handle the interference

Administrative Patent Judge Sally Gardner-Lane has been designated to handle the interference. 37 CFR § 1.610(a).

Part C. Standing order

A Trial Section STANDING ORDER accompanies this NOTICE DECLARING INTERFERENCE. The STANDING ORDER applies to this interference.

Part D. Conference call to set dates

A telephone conference call to set dates for taking action in the interference is scheduled for **2:00 pm on 1 May 2001** (the call will be initiated from the PTO).

No later than **two business days** prior to the conference call, each party shall file and serve by facsimile a list of the preliminary motions the party intends to file. See § 17 of the STANDING ORDER.

A copy of a "sample" order setting times for taking action during the preliminary motion phase of the interference accompanies this NOTICE DECLARING INTERFERENCE.

Counsel are encouraged to discuss the order prior to the conference call with the view to coming to some mutual agreement as to dates for taking action. A typical preliminary motion period lasts approximately nine (9) months. Counsel should be prepared to justify any request for a shorter or longer period.

Part E. The parties involved in this interference are:

Junior Party

Named inventors: Myun Ki Han
Silver Spring, Maryland

S. Paul Lee
Phoenix, Maryland

Jack G. Chirikjian
Potomac, Maryland

Application: US 09/069,847,
filed 30 April 1998

Title: FLUOROMETRIC ASSAY FOR DETECTING NUCLEIC
ACID CLEAVAGE

Assignee: None of record

Accorded Benefit: US 08/706,135, filed 30 August 1996,
issued as 5,763,181 on 9 June 1998

US 08/365,473, filed 30 December 1994

Attorneys: See last page

Address: See last page

Senior Party

Named Inventors:

Kenneth J. Livak
San Jose, California

Susan J.A. Flood
Fremont, California

Jeffrey Marmaro
Foster City, California

Application:

US 08/340,558, filed 16 November 1994,
issued as 5,538,848 on 23 July 1996

Title:

METHOD FOR DETECTING NUCLEIC ACID
AMPLIFICATION USING SELF-QUENCHING
FLUORESCENCE PROBE

Assignee:

Applied Biosystems, Perkins-Elmer
Corporation

Accorded Benefit:

None

Attorneys:

See last page

Address:

See last page

Part F. Count and claims of the parties

Count 1

A method according to claim 102 of Han (09/069,847)

or

a method according to claims 1, 14, or 24 of Livak
(5,538,848).

The claims of the parties are:

Han: 66-100 and 102-108

Livak: 1-24

The claims of the parties which correspond to Count 1 are:

Han: 102-108

Livak: 1, 3, 14, and 24

The claims of the parties which do not correspond to
Count 1, and therefore are not involved in the interference, are:

Han: 66-100

Livak: 2, 4-13, and 15-23

Part G. Heading to be used on papers

The following heading shall be used on papers filed in the interference. See § 18 of the STANDING ORDER.

Paper ____¹

Filed on behalf of [name of party]
By: Name of lead counsel, Esq.
Name of backup counsel, Esq.
Street address
City, State, and Zip-Code
Tel:
Fax:

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Administrative Patent Judge Sally Gardner-Lane)

MYUN KI HAN,
S. PAUL LEE, and JACK G. CHIRIKJIAN,
Junior Party,
(Patent Application 09/069,847),

v.

KENNETH J. LIVAK,
SUSAN J.A. FLOOD, and JEFFREY MARMARO,

Senior Party,
(Patent 5,538,848).

Patent Interference No. 104,670

TITLE OF PAPER

¹ Leave a blank line because the board assigns the paper number.

Part H. Summary of dates for taking action

Times for taking action are set out in the following sections of the STANDING ORDER:

1. § 7: date for identifying lead and backup counsel.
2. § 8: date for identifying any real party in interest.
3. § 9: date for requesting copies of involved and benefit applications and patents.
4. § 17: date for filing list of proposed preliminary motions.
5. § 19: date for accomplishing certain discovery.
6. § 20: date for filing clean copy of claims.
7. § 21: date for filing clean copy of claims in cases with drawings and/or claims containing a means plus function limitation.
8. § 23: dates for filing oppositions to Rule 635 miscellaneous motions and dates for filing replies to oppositions.
9. § 33: date for objecting to admissibility of evidence.
10. § 34: date for serving supplemental affidavits or evidence to respond to objection to admissibility of evidence.
11. § 35: dates when cross-examination can take place.
12. § 45: dates for taking action with respect to settlement discussions

Part I: Order form for requesting file copies

FILE COPY REQUEST

Interference 104,670

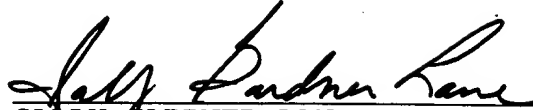
A copy of Part E of this NOTICE DECLARING INTERFERENCE should be attached to this FILE COPY REQUEST, with a circle by hand around the patents and applications for which a copy of a file wrapper is desired.

To facilitate processing of this FILE COPY REQUEST, the following information should be included:

1. Charge fees to USPTO Deposit Account No. _____
2. Complete address, including street, city, state, zip code and telephone number (do not list a Post Office box inasmuch as file copies are sent via commercial overnight courier).

Telephone, including area code: _____

Part J. Signature of administrative patent judge


SALLY GARDNER-LANE
Administrative Patent Judge

28 February 2001
Arlington, VA

Enc:

Copy of STANDING ORDER

Copy of order used for setting times for taking action in
the preliminary motion phase of the interference (ORDERPM6)

Copy of order used for setting times for taking action in
the testimony and briefing phases of the interference
(ORDERTE6)

PTO Form 850

Copy of examiner's explanation

Copy of claims 102-108 of US 09/069,847

Copy of US 5,538,848

DECLARE.007
Revised 12 October 2000
(replaces DECLARE.006.1)

cc (via Federal Express):

Attorney for Han:

Robin L. Teskin, Esq.
BURNS, DOANE, SWECKER & MATHIS
1737 King Street
Alexandria, VA 22314

Attorney for Livak (real party in interest: Applied Biosystems,
Perkins-Elmer Corporation):

Patti Selan, Esq.
Patent Administrator
APPLIED BIOSYSTEMS
850 Lincoln Centre Drive
Foster City, CA 94404